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## REPORT ON THE

FILING OR DETERMINATION OF AN  
ACTION REGARDING A PATENT OR  
TRADEMARK

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been  
filed in the U.S. District Court Northern District of California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. CV 08-03139 WDB	DATE FILED July 2, 2008	U.S. DISTRICT COURT Northern District of California, 1301 Clay Street, RM 400S, Oakland, CA 94612
PLAINTIFF CORBETT LIFE SCIENCE		DEFENDANT APPLERA CORPORATION
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 6,814,934		See Attached
2		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		See Attached
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK Richard W. Wicking	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner  
Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

1           52.     Upon information and belief, Dr. Higuchi worked with Dr. Dollinger and had  
2 knowledge of this machine. In a 2005 article he co-authored, Dr. Higuchi described working with Dr.  
3 Dollinger in the development of real-time PCR. This article, entitled "Fifty Years of Molecular  
4 (DNA/RNA) Diagnostics" is attached hereto as Exhibit G. In the article Dr. Higuchi describes using a  
5 machine the same as described in Example VIII of the '934 patent, to demonstrate real-time PCR.  
6 (*See, e.g.*, Exhibit G, page 2, right column.)

7           53.     Upon information and belief, this article was received on November 11, 2004, accepted  
8 on December 14, 2004, and first published online on January 13, 2005. The '934 patent issued on  
9 November 9, 2004.

10          54.     An intent to deceive the USPTO can be inferred from the fact that Dr. Higuchi signed a  
11 declaration claiming to be the sole inventor of the '934 patent, then nearly simultaneous with the  
12 issuance of that patent, he co-authored and submitted an article for publication that described working  
13 with Dr. Dollinger and using a machine of the same design as Dr. Dollinger's to demonstrate real-time  
14 PCR.

15          55.     An intent to deceive the USPTO can be inferred from the fact that the '934 patent  
16 specification includes disclosure of Dr. Dollinger's initial design of a real-time PCR machine  
17 (described above at ¶¶ 38-45) that fulfills the requirements of claims 1 and 7 but the material  
18 information of Dr. Dollinger's independent conception of this machine was not disclosed to the  
19 USPTO.

20          56.     An intent to deceive the USPTO can be inferred from the fact that the '934 patent  
21 specification includes disclosure of Dr. Dollinger's design and construction of a real-time PCR  
22 machine (described above at ¶¶ 46-51) that fulfills the requirements of claims 1 and 7 but the material  
23 information of Dr. Dollinger's independent conception and reduction to practice of this machine was  
24 not disclosed to the USPTO.

25          57.     A judicial determination and declaration of unenforceability is necessary and  
26 appropriate to resolve this controversy and so that the parties may ascertain their respective rights and  
27 duties.  
28

1 **JURY DEMAND**

2 58. Under Rule 38(b) of the Federal Rules of Civil Procedure, Corbett respectfully requests  
3 a jury trial on all issues and claims.

4 **PRAYER FOR RELIEF**

5 WHEREFORE, Corbett prays for judgment against Applera, and that the Court award the  
6 following relief:

7 A. Declare that Corbett does not infringe and has not infringed, either directly or indirectly,  
8 any valid and enforceable claim of the '934 patent, either literally or under the doctrine of equivalents;

9 B. Declare that the claims of the '934 patent are invalid;

10 C. Declare that the claims of the '934 patent are unenforceable;

11 D. Find this case exceptional and award Corbett its attorneys' fees under 35 U.S.C. § 285;

12 E. Award Corbett its expenses and costs incurred in this action;

13 F. Enjoin Applera, their officers, agents, servants, employees, attorneys, and any person  
14 who acts in concert or participation with Applera from threatening to assert or otherwise attempting to  
15 enforce the '934 patent against Corbett, its customers, suppliers, or anyone in privity with Corbett and  
16 from representing to anyone, either directly or indirectly, that Corbett has infringed or is infringing,  
17 directly or indirectly, the '934 patent; and

18 G. Such other and further relief as this Court deems just and proper.

19  
20 Dated: June 30, 2008

Respectfully submitted,

21  
22 By: 

23 Henry C. Bunsow  
24 David L. Bilsker  
25 Daniel T. Shvodian  
26 Adam K. Whiting

27 Attorneys for Plaintiffs  
28 CORBETT LIFE SCIENCE,  
CORBETT ROBOTICS INC., and  
CORBETT RESEARCH PTY LTD.

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FILED

JUN 10 2008

RICHARD W. WIEKING  
CLERK, U.S. DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

E-filing

WDB

3139

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

CV 08

) Case No.

) **COMPLAINT FOR DECLARATORY  
JUDGMENT**

) **DEMAND FOR JURY TRIAL**

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11 Attorneys for CORBETT LIFE SCIENCE,  
CORBETT ROBOTICS INC., and  
12 CORBETT RESEARCH PTY LTD.

13  
14  
15  
16  
17 CORBETT LIFE SCIENCE;  
CORBETT ROBOTICS INC.; and  
18 CORBETT RESEARCH PTY LTD.,

19 Plaintiffs,

20 vs.

21 APPLERA CORPORATION and APPLIED  
BIOSYSTEMS,

22 Defendants.  
23

24  
25 Plaintiffs Corbett Life Science, Corbett Robotics Inc. ("Corbett Robotics"), and Corbett  
26 Research Pty Ltd. ("Corbett Research") (collectively "Corbett") complain against Defendants Applera  
27 Corporation and Applied Biosystems Inc. (collectively "Applera"), demand a jury trial, and allege as  
28 follows:

HOWREY LLP  
COMPLAINT FOR DECLARATORY JUDGMENT

1 **NATURE OF THE ACTION**

2 1. In this action, Corbett seeks a declaratory judgment of non-infringement, invalidity,  
3 and/or unenforceability of Applera's U.S. Patent No. 6,814,934, ("the '934 patent") pursuant to the  
4 Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*, the patent laws of the United States, 35 U.S.C.  
5 § 1, *et seq.*, and other such relief as the Court deems just and proper.

6 **PARTIES**

7 2. Plaintiff Corbett Life Science is a corporation organized and existing under the laws of  
8 Australia, having its principal place of business in Mortlake, NSW, Australia.

9 3. Plaintiff Corbett Research is a wholly-owned subsidiary of Corbett Life Science  
10 organized and existing under the laws of Australia, having its principal place of business in Mortlake,  
11 NSW, Australia.

12 4. Plaintiff Corbett Robotics is a wholly-owned subsidiary of Corbett Life Science and a  
13 corporation organized and existing under the laws of California, having its principal place of business  
14 at 185 Berry Street, Suite 5200, San Francisco, California.

15 5. Upon information and belief, Defendant Applera Corporation is a Delaware  
16 Corporation with its principal place of business at 301 Merritt 7, Norwalk, Connecticut.

17 6. Upon information and belief, Defendant Applied Biosystems Inc. is an operating group  
18 of Applera Corporation with its principal place of business at 850 Lincoln Centre Drive, Foster City,  
19 California.

20 **JURISDICTION AND VENUE**

21 7. This Court has jurisdiction over the subject matter of this action because it seeks a  
22 declaratory judgment under 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202 and 35 U.S.C. § 101 *et seq.*  
23 regarding an actual and justiciable controversy between the parties hereto over whether the '934 patent  
24 is valid, infringed, and enforceable.

25 8. This Court has personal jurisdiction over Applera because upon information and belief,  
26 Applera Corporation and Applied Biosystems reside in and/or engage in significant business activities  
27 in this district, including maintaining offices in this district, employing corporate representatives in this  
28

1 district, selling products in this district, soliciting business in this district, targeting customers in this  
2 district, and/or deriving substantial revenue from this district, among other things.

3 9. Venue is proper in this judicial district under 28 U.S.C. §§ 1391(a), 1391(b), 1391(c)  
4 and/or 28 U.S.C. § 1400(b) because, upon information and belief, Applied Biosystems and Applera  
5 Corporation reside in and/or engage in significant business activities in this district.

6 **FACTUAL BACKGROUND**

7 **APPLERA'S INFRINGEMENT ALLEGATIONS AGAINST CORBETT'S PRODUCTS**

8 10. Plaintiff Corbett Life Science is the Australian parent company of a group of  
9 biotechnology companies, including plaintiffs Corbett Research and Corbett Robotics, that design,  
10 manufacture and internationally distribute instrumentation systems for the life sciences. Corbett's  
11 most recognized products are the world's first rotary real-time DNA amplification systems called  
12 "Rotor-Gene<sup>TM</sup>."

13 11. Corbett currently sells its Rotor-Gene<sup>TM</sup> products in the United States.

14 12. Upon information and belief, Applera is the assignee of record of U.S. Patent No.  
15 6,814,934 B1 entitled "Instrument For Monitoring Nucleic Acid Amplification" (the "'934 patent"),  
16 which was filed on November 12, 1997, and issued on November 9, 2004. The sole inventor named on  
17 the '934 patent is Russell Gene Higuchi. A copy of the '934 patent is attached hereto as Exhibit A.

18 13. Upon information and belief, Applera is the exclusive authorized and registered  
19 proprietor of European Patent EP 0 872 562 B1 entitled "Instrument for monitoring nucleic acid  
20 amplification reactions," (the "'562 EP"). A copy of the '562 EP is attached hereto as Exhibit B.

21 14. The sole inventor named on the '562 EP is Russell Gene Higuchi, who is the same sole  
22 inventor named on the '934 patent.

23 15. The priority patent application listed on the '562 EP is United States patent application  
24 695,201, filed May 2, 1991, which is the identical priority patent application as listed on the '934  
25 patent.

26 16. The language of claim 1 of the '934 patent is nearly identical to the language of claim 1  
27 of the '562 EP. A chart comparing the claim language is attached hereto as Exhibit C.

1           17.     On March 28, 2008, Applera's counsel sent Corbett a letter under the subject heading  
2 "Infringement of patent EP 0 872 562 by the Rotor-Gene 3000 and Rotor-Gene 6000," which is  
3 attached as Exhibit D.

4           18.     In the letter, Applera's counsel stated: (1) the features of claim 1 of the '562 EP;  
5 (2) that Applera had become aware of the Rotor-Gene<sup>TM</sup> 3000 and Rotor-Gene<sup>TM</sup> 6000 devices on  
6 Corbett's website; (3) that the Rotor-Gene<sup>TM</sup> 3000 and Rotor-Gene<sup>TM</sup> 6000 products realize all features  
7 of claim 1 of the '562 EP; (4) that Corbett had infringed Applera's exclusive rights; and (5) that  
8 Corbett was liable for damages, must destroy its products, and pay attorney's fees.

9           19.     In the letter, Applera's counsel offered Corbett an opportunity to "settle this dispute" by  
10 signing, unchanged an attached "Cease and Desist Declaration" requiring Corbett to refrain from  
11 "offering, using, putting in circulation or importing or possessing for the mentioned purposes in the  
12 Federal Republic of Germany" and "destroy" the apparatus described by the language of claim 1 of the  
13 '562 EP.

14           20.     In the letter, Applera's counsel also attached a patent infringement complaint and stated  
15 that the complaint would be "made pending without further notice" should Corbett not return the  
16 signed Cease and Desist Declaration by April 17, 2008.

17           21.     Corbett did not sign the Cease and Desist Declaration and on April 18, 2008, Applera  
18 filed a complaint for patent infringement with the German District Court in Dusseldorf. A copy of  
19 Applera's German patent infringement complaint against Corbett is attached hereto as Exhibit E.

20           22.     Corbett currently sells and has plans to continue to sell in the United States the same  
21 Rotor-Gene<sup>TM</sup> products that Applera has accused of infringing the claims of EP '562. Corbett believes  
22 it has a right to manufacture, import, use, sell, and offer for sale its Rotor-Gene<sup>TM</sup> products in the  
23 United States.

24           23.     However, based on Applera's accusations regarding the '562 EP claims and its filing of  
25 the German patent infringement lawsuit, Corbett believes that there is a real and imminent danger that  
26 Applera will sue Corbett for infringement of the nearly identical claims of the '934 patent based on its  
27 sales of the Rotor-Gene<sup>TM</sup> products in the United States.

24. Corbett believes that Applera's actions regarding the '562 EP have put Corbett in the position of either risking a suit for infringement of the '934 patent by continuing to sell its Rotor-Gene<sup>TM</sup> products in the United States or abandoning the market until the '934 patent expires.

25. Thus, a valid and justiciable controversy regarding the patents-in-suit has arisen between Corbett and Applera that is properly presented for judicial relief under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202.

### **FIRST CLAIM FOR RELIEF**

#### **(Request for Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,814,934)**

26. Corbett realleges and incorporates herein by reference the allegations contained in Paragraphs 1 through 25.

27. A valid and justiciable controversy within the meaning of 28 U.S.C. § 2201 has arisen and exists between Corbett and Applera regarding the infringement of the '934 patent.

28. Corbett has not infringed, has not willfully infringed, is not now infringing, has not contributorily infringed, and has not induced infringement any valid and enforceable claim of the '934 patent either literally or under the doctrine of equivalents.

29. Applera is also estopped from asserting that the claims of the '934 patent have been infringed by Corbett because the claims of the '934 patent were so restricted and limited in scope during the prosecution of the application upon which the patent issued so as to distinguish the alleged invention from the prior art, to overcome the objections of or rejection by the examiner, and to induce the issuance of the patent that said claims cannot be construed as describing or embracing any activities, instruments, products, or methods used, promoted, or induced by Corbett.

30. A judicial determination and declaration of non-infringement is necessary and appropriate to resolve this controversy and so that the parties may ascertain their respective rights and duties.

### **SECOND CLAIM FOR RELIEF**

#### **(Request for Declaratory Judgment of Invalidity of U.S. Patent No. 6,814,934)**

31. Corbett realleges and incorporates herein by reference the allegations contained in Paragraphs 1 through 30.



32. A valid and justiciable controversy within the meaning of 28 U.S.C. § 2201 has arisen and exists between Corbett and Applera regarding the validity of the '934 patent.

33. The '934 patent is invalid because it fails to satisfy the conditions and requirements for patentability as set forth in at least 35 U.S.C. §§ 101, 102, 103, and/or 112, and due to double patenting.

34. A judicial determination and declaration of invalidity is necessary and appropriate to resolve this controversy and so that the parties may ascertain their respective rights and duties.

### **THIRD CLAIM FOR RELIEF**

#### **(Request for Declaratory Judgment of Unenforceability of U.S. Patent No. 6,814,934)**

35. Corbett realleges and incorporates herein by reference the allegations contained in Paragraphs 1 through 34.

36. A valid and justiciable controversy within the meaning of 28 U.S.C. § 2201 has arisen and exists between Corbett and Applera regarding the enforceability of the '934 patent.

37. The '934 patent is unenforceable due to inequitable conduct before the United States Patent and Trademark Office ("USPTO"). Such conduct includes, but is not limited to, the applicant for the '934 patent, Russell Gene Higuchi, not disclosing the true inventorship of the '934 patent with an intent to deceive the USPTO.

38. On January 22, 1998, Dr. Higuchi executed a declaration submitted to the USPTO asserting that he was the sole inventor of the application that ultimately issued as the '934 patent. This inventor declaration is attached hereto as Exhibit F. As a result of this declaration, the USPTO listed Dr. Higuchi as the sole inventor of the '934 patent.

39. But, upon information and belief, Dr. Higuchi worked together with Dr. Gavin Dollinger at Cetus on a project to label materials with unique pieces of DNA that could be detected by amplification using the polymerase chain reaction ("PCR"). During the course of that project, a technician mistakenly added a fluorescent dye for labeling DNA called ethidium bromide to a PCR amplification tube at the beginning rather than the end of the amplification reaction.

1           40.     Dr. Higuchi asserted that it was to his surprise that the ethidium bromide did not inhibit  
2 the amplification reaction. As a result, Dr. Higuchi claims to have come upon the invention of a  
3 method to detect the progress of a PCR amplification in real-time (*i.e.*, "real-time PCR").

4           41.     Dr. Dollinger was an expert in making analytical machines used to monitor chemical  
5 reactions. Upon information and belief, Dr. Dollinger also learned of the technician's PCR  
6 amplification mistakenly performed with ethidium bromide added at the beginning. Based upon this,  
7 Dr. Dollinger realized that a machine should be created which could act as a thermocycler and detect  
8 fluorescence and thereby follow the PCR amplification process in real-time.

9           42.     Upon information and belief, Dr. Dollinger first conceived of such a real-time PCR  
10 machine as consisting of a spectrofluorometer, which measures fluorescence, with a temperature-  
11 controlled sample chamber that could be heated and cooled. This initial design for the machine is  
12 described in the '934 patent at col. 12, lines 14-17. ("In a spectrafluorometer capable of heating and  
13 cooling a surface, or vessel, an optic fiber is not required. The optic fiber is only necessary where a  
14 thermocycler and spectrafluorometer are housed independently.")

15           43.     Upon information and belief, Dr. Higuchi (or others involved in the preparation of the  
16 '934 patent application) had knowledge of Dr. Dollinger's initial design and included a description of  
17 it in the specification.

18           44.     Dr. Dollinger's initial design for a real-time PCR machine fulfills the requirements of  
19 the instrument and system recited in at least claims 1 and 7 of the '934 patent.

20           45.     Claim 1 of the '934 patent requires:

21                   An instrument for use in monitoring a nucleic acid amplification reaction  
22                   comprising multiple thermal cycles, comprising:  
23                   (a) an automated thermal cycler capable of alternately heating and cooling,  
24                   and adapted to receive, at least one reaction vessel containing an  
25                   amplification reaction mixture comprising a target nucleic acid, reagents  
26                   for nucleic acid amplification, and a detectable nucleic acid binding agent;  
27                   and  
28                   (b) a detector operable to detect a fluorescence optical signal while the  
                    amplification reaction is in progress and without opening the at least one  
                    reaction vessel, which fluorescence optical signal is related to the amount  
                    of amplified nucleic acid in the reaction vessel.

27           46.     Claim 7 of the '934 patent requires:

28                   A system for use in monitoring a nucleic acid amplification reaction  
                    comprising multiple thermal cycles, comprising:

(a) at least one reaction vessel adapted to contain an amplification reaction mixture comprising a target nucleic acid, reagents for nucleic acid amplification, and a detectable nucleic acid binding agent;  
(b) an automated thermal cycler capable of alternately heating and cooling such a reaction vessel, and  
(c) a detector operable to detect a fluorescence optical signal while the amplification reaction is in progress and without opening the at least one reaction vessel, which fluorescence optical signal is related to the amount of amplified nucleic acid in the reaction vessel.

47. Upon information and belief, Dr. Dollinger conceived of the initial design for the real-time PCR machine without Dr. Higuchi telling him what to do or supervising him. Dr. Dollinger is an inventor of at least '934 patent claims 1 and 7.

48. Furthermore, information regarding Dr. Dollinger's development of this initial design for a real-time PCR machine is material to the patentability of the '934 patent. However, the '934 patent and file history nowhere disclose Dr. Dollinger's conception of this initial design.

49. Upon information and belief, after performing some work on this initial design, Dr. Dollinger decided to pursue another design to implement a machine for real-time PCR. Dr. Dollinger next conceived of, designed, and built a machine that is the same as described in Example VIII of the '934 patent. (*See, e.g., '934 patent, col. 23, lines 2-45.*) This machine included a spectrafluorometer with a fiber optic connected to a PCR tube containing an amplification reaction placed in a thermocycler. The machine was capable of alternately heating and cooling the PCR tube and measuring a fluorescence optical signal while an amplification reaction was in progress. This machine fulfilled the requirements of the instrument and system recited in at least claims 1 and 7 of the '934 patent.

50. Upon information and belief, Dr. Dollinger conceived of, designed, and built a machine for real-time PCR the same as disclosed in Example VIII without Dr. Higuchi telling him what to do or supervising him. Dr. Dollinger is an inventor of at least '934 patent claims 1 and 7.

51. Furthermore, information regarding Dr. Dollinger's development of the machine of Example VIII is material to the patentability of the '934 patent. However, the '934 patent and file history nowhere disclose Dr. Dollinger's conception, design, and building of this machine for real-time PCR.